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U.S. Appl. No. 10/526,320 | response to action posted 18-Mar'09

Remarks and Amendment dated: 18-June'09

**REMARKS/ARGUMENT**

Applicant – through the assignee of this technology/application – has given careful consideration to the grounds of the examiner in rejecting the claims under 35 USC §102(b). Each amendment made herein has been made for purposes of clarification of the subject matter sought to be patented, as originally filed in the PCT International application and for which national U.S. entry was made on behalf of applicant by applicant's assignee. All amendments enjoy full support of the specification, claims, drawings, and abstract as filed. No new matter is included. Each independent claim recites distinguishable features, as does each claim depending therefrom: Applicant respectfully solicits reconsideration of the outstanding rejections.

**Rejection under 35 USC §102(b) using Winthrop et al Pat. N° 5,891,187 ('Winthrop')**

Claims 1–3 and 10–13 stand rejected under §102(b) as being anticipated by Winthrop. Winthrop discloses (col. 1, lines 10–15):

... a human shaped [that is, *flat* in the shape of a ginger-bread cookie] heating or cooling pad placed beneath a patient allowing heat or cold to radiate upwards. The pad includes thermally insulated straps which can be used to further insulate and selectively secure various parts of the patient's body to the pad.

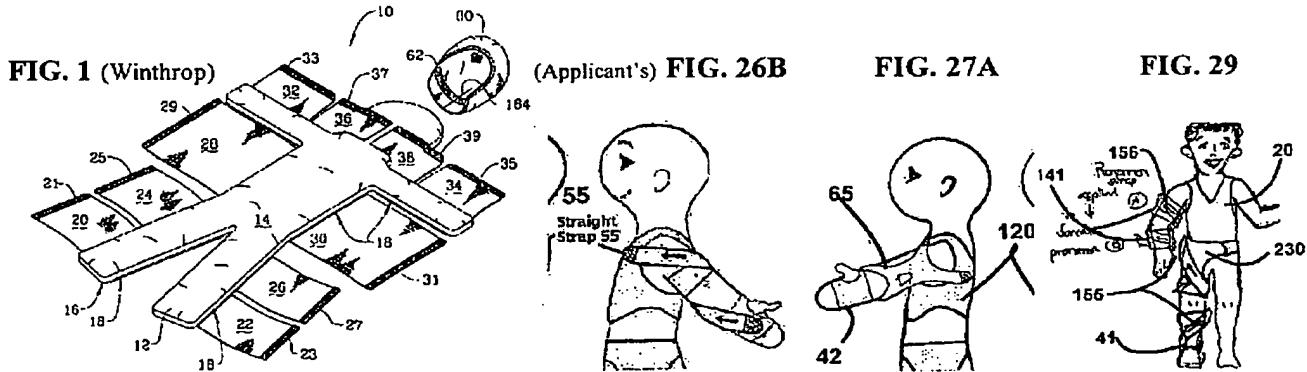
The lower surface 16 of the flat ginger-bread cookie shaped pad 12 on which a patient lies has a series of attachments strips 18. Strips 18 are used to attach the straps. The straps are composed of paired-up modularized insulation sections 20–38 (evens); each of these sections of straps has a corresponding attachment strip with an upward facing attachment surface for use to attach the sections to the underside of flat pad 12. Each modularized insulated section 20–38 (evens) includes a VELCRO® attachment strip 21–39 (odds) at the free end. "As the section is wrapped around the particular body part of the patient, the attachment strip 21–39 (odds) might be attached to the corresponding receiving surface 18 underneath the pad." See, col. 6, lines 49–56.

The ginger-bread cookie shaped pad 12 is "human shaped and formed to lie underneath the patent [sic] so as to conform to the shape of the prone or supine body with outstretched arms and legs. The heating or cooling pad is formed from a chemical pack which can generate heat or cold upon activation according to the prior art [see, col. 6, lines 16–23]." Winthrop continues, by explaining how the straps are used in operation with the flat pad 12:

The torso sections 28–30 might be formed wide enough so that only one section needs to be used and can be wrapped around the patient's body and secured underneath on the other side. ... Each chest section 36–38 folds downward from the shoulder portion of the arm and across the left and right chest areas of the patient. The attachment strips 37–39 on the chest sections would attach to corresponding receiving strips (not shown) on the underside of the torso sections 28–30 [see, col. 6, line 64 – col. 7, line 8].

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Applicant's therapeutic garment system, as claimed, is patentably distinguishable from the structure and interconnection of Winthrop's ginger-bread cookie shaped thermal pad assembly. Applicant's amended claims recite a unique combination of structures operable as a therapeutic garment system, comprising a first and second elasticized garment and a plurality of separate elasticized pieces, at least a first of which interconnects the first and second garment. Further recited are the following: elasticized wrap-around first and second garments for donning and releasably securing in a close-fitting fashion at generally different areas of the body; each of the garments comprises an outwardly facing surface adapted for accepting an area of releasable fasteners, and an under-layer having an inwardly facing surface to resist slippage when donned; a plurality of separate elasticized pieces, each of which comprises at least one of the areas of releasable fasteners for application onto the outwardly facing surfaces; the area of releasable fasteners of a first of the elasticized pieces is employed for releasable application against an outwardly facing surface of each of the garments in an operative therapeutic configuration. As explained by applicant in the specification, and supported in the many figures: Each garment may be donned by pulling onto the respective area of the body, or by wrapping therearound and releasably securing using one or more of the elasticized pieces. A few of applicant's figures are copied below for handy comparison, here, with the Winthrop thermal pad design:



As pointed out above (for handy reference, see above, FIG. 1), Winthrop discloses thermally insulated straps to further insulate and selectively secure various parts of the patient's body to the flat pad 12 (on which a patient lies): the straps are composed of paired-up modularized insulation sections 20-38 (evens) that are connected to the pad at various selected positions therealong. Missing from Winthrop are key claimed features: No separate elasticized pieces for interconnecting at least a first and second garment are disclosed. There is no need. In fact, it would make no sense for Winthrop to add such pieces, as uniquely claimed by applicant.

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**Rejection under 35 USC §102(b) using Phillips, Sr. et al Pat. N° 4,843,647 ('Phillips, Sr.')**

Claims 1–3, 5–10, and 12–14 stand rejected under §102(b) as anticipated by Phillips, Sr. Phillips, Sr. discloses a cold weather system to provide protection in the temp range of -20°F to 40°F (col. 1) comprising conventional outdoor components: cold weather shirt 10, pants 11, footwear 12, mittens 13, hat 14, (col. 3); hood (col. 5); and cold weather parka 80, wind pants 88, wind mitts 89 (co. 7). The examiner applies Phillips, Sr. on p. 4 of the action:

Phillips, Sr. et al discloses garment system comprising an upper torso garment (10), a lower torso garment (11), and a plurality of elasticized pieces (12, 13, 34) and fasteners (41) [are] releasably applied to the garments (10, 11).

Phillips, Sr., col. 5, lines 31–35, explains where fasteners 41 are used: "The chin portion of the hood 34 is sealed when the garment is not vented by fasteners 41 mounted on cooperating flaps 42. . . . as illustrated in FIGS. 4 and 7." Fasteners 41 (tiny strips of hooks and loops) are effectively permanently secured at an inner lining of the neck area of the Phillips, Sr. multi-layered, loose-fitting shirt 10, for accepting hood 34. The following of applicant's claimed invention feature has been 'read on' (compared to) this loose-fitting shirt 10: elasticized wrap-around upper-torso garment for donning and releasably securing in a close-fitting fashion.

A closer look at applicant's claimed invention reveals that, once again (as is the case with Winthrop), no comparable features exist in Phillips, Sr. structured and operable as claimed by the applicant, including: A plurality of separate elasticized pieces, each of which comprises at least one of the areas of releasable fasteners for application onto any of the outwardly facing surfaces. The area of releasable fasteners of a first of the elasticized pieces is employed for releasable application against an outwardly facing surface of each of the first and second wrap-around garments in a configuration operatively interconnecting the first and second garments. It is each garments' outwardly facing surface that is adapted for accepting the area of releasable fasteners on the elasticized pieces. The interconnection is made in an operative therapeutic configuration.

**Fig. 1** from Phillips, Sr. et al



**Fig. 2**

(Applicant's) FIG. 26B

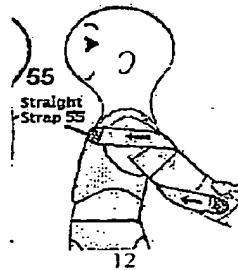


FIG. 27A

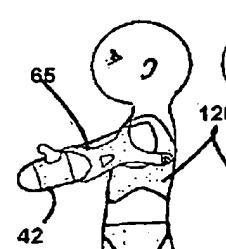
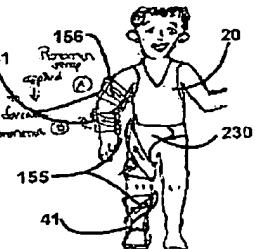


FIG. 29



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Rejections under 35 USC §102 |Anticipation & §103 |Obviousness – Legal Summary

As we know: "For a prior art reference to anticipate in terms of 35 U.S.C. §102, *every* element of the claimed invention must be identically shown in a single reference . . . These elements must be arranged as in the claim under review . . .," *In re Bond* (Fed. Cir. 1990). The Federal Circuit has reiterated that "[t]here must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention, [*Scripps Clinic & Research Foundation*]". A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim. See *Verdegaal Bros., Inc. v. Union Oil Co.* (Fed. Cir. 1987). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.* (Fed. Cir. 1986). An anticipation rejection under §102 can stand against a pending claim *only* if a single piece of prior art discloses a combination including *each* element of the pending claim such that each prior art element is identical to a corresponding, similar structurally-arranged and operationally substantial equivalent element of the pending claim. This is not the case, here. For reasons enumerated, applicants submit that all independent claims, as well as dependent claims, include features not disclosed by any reference cited.

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The Supreme Court continued "[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." *Id.* The Court explained, "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Id.* at 1740-41, 82 USPQ2d at 1396. The Court noted that "[t]o facilitate review, this analysis should be made explicit." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

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Further, while precedent from the federal courts has shifted somewhat, in certain aspects, toward providing greater flexibility to examiners in rejecting claims during examination, it is still impermissible to apply hindsight in combining references or when using artisan general technical knowledge to draw conclusions in support of rejections.

Here, it is *not* a case of a substitution of one element—for instance, a mechanical actuator device replaced by a processor-driven device to perform the same function—as was the case set out by the Federal Circuit where it concluded, upon application of *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007) that it would have been obvious to combine (1) a mechanical device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) an electronic, processor-driven device capable of playing the sound associated with a first letter of a word in a book. See *Leapfrog Ent., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161, 82 USPQ2d 1687, 1690-91 (Fed. Cir. 2007) (“[a]ccommodating a prior art mechanical device that accomplishes [a desired] goal to modern electronics would have been reasonably obvious to one of ordinary skill in designing children's learning devices”). *But rather*, the applicant has designed a garment system combining structures in a very unique manner having been faced with complex|unordinary design issues, as explained in applicant's specification.

#### Summary and Request for Reconsideration

Each identified reference is **silent** as to key claimed features and no suggestion or teaching to modify or to combine any identified reference with any other exists. Indeed, no support exists in favor of maintaining the rejections. One would need to make an impermissible ‘leap’ to read Winthrop or Phillips, Sr. as teaching or suggesting applicant's unique garment system. Such a ‘leap’ could only be made if one were to ignore descriptive language of features recited in the claims, as supported by the spec and figures. This is a type of [*in*]action not permitted under our Patent Laws. The garment system invented is **different** and **unobvious** from any contemplated by others. As such, applicant's claims stand patentable and overcome the rejections. Each reference stops short of appreciation to arrive at the innovation claimed in applicants' independent claim. And, *although each dependent claim depending from an independent claim containing patentable subject matter is also considered patentably distinct by way of inclusion of features of a respective patentable independent claim*, applicant's dependent claims include further unique limitations. Favorable reconsideration is respectfully solicited.

Respectfully submitted this 18<sup>th</sup> day of June 2009



**Macheleldt Bales & Heidmiller LLP**  
Jean M Macheleldt | Reg. N° 33,956 | Tel. 970.218.6798  
Attorney of Record for Assignee|Applicant(s)